

Remarks:

The present amendment is in response to the office action dated July 27, 2005 in the above-identified patent application.

In the office action, claims 1-25 were pending, with claims 1-12, 19, and 20 being allowed, and claims 13-18 and 21-25 being rejected. Claims 1-25 remain in this application, with no claims having been amended, and no claims having been cancelled.

Summary of Examiner rejections and Applicant responses

Turning to the rejections over the prior art the in the office action on page 2, in paragraph 2, the Examiner stated that claims 13-18, 21, and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 1,792,338 to Walz. The Examiner states that Walz discloses an adjustable wrench comprising, a handle member having a longitudinal axis between a handle first end portion (1) with a fixed jaw segment (3) with surface plane, having a transverse axis that is substantially parallel to a channel therethrough (5), an opposing handle second end portion, and a handle central portion (Figure 1). The Examiner also stated that Walz discloses a void (19) in communication with the channel (5) with the void (19) having a longitudinal axis (Figure 1) in addition to a movable jaw member (9) with surface plane, having an engagement portion (17) slidably engaged within the channel (5) between open and closed states, with a serrated toothed rack (15) whose pitch line forms an acute angle in

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relation to the movable jaw surface plane (Column 3, lines 28-34). The Examiner also stated that Walz discloses a beam (20) having reciprocating movement within the void (19) with the beam (20) projecting into the channel (5) and having a serrated toothed rack (21) that selectively matingly engages with the serrated toothed member of the movable jaw (9) thus preventing movement of the movable jaw (9), also disclosed is a spring (18) to urge the movable jaw (9) from the open to the closed state, allowing the movable jaw (9) and fixed jaw (3) to be placed upon a fastener for loosening or tightening. In addition, the Examiner stated that Walz discloses a beam extension lever structure (27) (Figure1) that is operational to manually disengage the beam (20) and movable jaw (9) toothed racks (21 and 15) with reciprocating finger action causing the beam (20) to compress the spring (24), also Walz has an aperture located in the handle second end portion (Figure 1) that can suspend the handle member.

In the office action page 4, paragraph 3, the method the Examiner stated that Walz discloses the steps of providing an adjustable wrench, grasping the handle member, manually disengaging the toothed racks (21 and 15), moving the trigger, positioning the fixed jaw (3) and the movable jaw (9) on the fastener, manually releasing the means to engage the toothed rakes (21 and 15), applying manual force to the handle, and repeating the aforementioned steps to tighten or loosen the fastener.

In response, please see the remarks detail section.

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In the office action on page 5, in paragraph 5, the Examiner rejected claim 22 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 1,792,338 to Walz, in view of U.S. Patent No. 6,799,493 to Wang, the Examiner stated that Walz discloses the applicant's invention as previously described, but lacks the faster size indicia visibly disposed on each end of the fixed jaw segments and movable jaw member to identify the relative jaw position corresponding to fastener size. The Examiner also stated that Wang discloses an index (29) on the surface of the lower jaw, and an index mark (151) to indicate the size of the clamping space between the index and index mark and it would of obvious to one of ordinary skill in the art at the time the invention was made to combine the adjustable wrench disclosed by Walz, with the fastener size indicia disclosed in Wang in order to identify the relative jaw position corresponding to a fastener size.

In response, please see the remarks detail section.

In the office action on page 5, in paragraph 6, the Examiner stated that claims 1-12, 19, and 20 are allowed.

Detailed explanation of reference teachings and amendment remarks

A 35 U.S.C. 102(b) rejection requires complete claim anticipation by a single reference, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d

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628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Also, "The identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Plus, the elements must be arranged as required in the claim, however, identical terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Walz teaches an adjustable wrench with a movable jaw (9) that is slidably engaged with a key hole slot (5) therethrough a head (1), with the movable jaw (9) having a toothed portion (15) wherein the movable jaw (9) is urged to the closed state with a spring (18), reference column 1, line 64 to column 2, line 16. Walz also teaches a locking latch (20) having a toothed portion (21) that selectively matingly engages with the toothed portion (15) of the movable jaw (9), the locking latch (20) is urged by spring (24) to engage toothed portions (15) and (21), reference column 2, lines 26-60. In addition, Walz teaches a lever (27) that selectively manually disengages toothed portions (15) and (21) by manually pushing on button (28) and conversely manually releasing the button (28) engages toothed portions (15) and (21) to lock the movable jaw (9), reference column 2, lines 42-81. The toothed portions (15) and (21) form a pitch line that is perpendicular to the movable jaw (9) surface plane, reference Figure 1. Note, that in referencing Figure 1 of Walz, if spring (24) exercised a high degree of urging, such that the toothed portions (15) and (21) were engaged with more

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force, it would not act to urge the movable jaw (9) to the closed state with the movable jaw (9) remaining in the static state.

Turning to the rejections over the prior art the in the office action on page 2, in paragraph 2, the Examiner stated that claims 13-18, 21, and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 1,792,338 to Walz. The Examiner states that Walz discloses an adjustable wrench comprising, a handle member having a longitudinal axis between a handle first end portion (1) with a fixed jaw segment (3) with surface plane, having a transverse axis that is substantially parallel to a channel therethrough (5), an opposing handle second end portion, and a handle central portion (Figure 1). The Examiner also stated that Walz discloses a void (19) in communication with the channel (5) with the void (19) having a longitudinal axis (Figure 1) in addition to a movable jaw member with surface plane (9), having an engagement portion (17) slidably engaged with in the channel (5) between open and closed states, with a serrated toothed rack (15) whose pitch line forms an acute angle in relation to the movable jaw surface plane (Column 3, lines 28-34). The Examiner also stated that Walz discloses a beam (20) having reciprocating movement with the void (19) with the beam (20) projecting into the channel (5) and having a serrated toothed rack (21) that selectively matably engages with the serrated toothed member of the movable jaw (9) thus preventing movement of the movable jaw (9), also disclosed is a spring (18) to urge the movable jaw (9) from the open to the closed state, allowing the movable jaw (9) and fixed jaw (3)

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to be placed upon a fastener for loosening or tightening. In addition, the Examiner stated that Walz discloses a beam extension lever structure (27) (Figure1) that is operational to manually disengage the beam (20) and movable jaw (9) toothed racks (21 and 15) with reciprocating finger action causing the beam (20) to compress the spring (24), also Walz has an aperture located in the handle second end portion (Figure 1) that can suspend the handle member.

In the office action page 4, paragraph 3, the method the Examiner stated that Walz discloses the steps of providing an adjustable wrench, grasping the handle member, manually disengaging the toothed racks (21 and 15), moving the trigger, positioning the fixed jaw (3) and the movable jaw (9) on the fastener, manually releasing the means to engage the toothed rakes (21 and 15), applying manual force to the handle, and repeating the aforementioned steps to tighten or loosen the fastener.

In response, the Examiner is directed to claim 13, element b, that has the following structural limitation at lines 7 and 8 of element b, that state "whose pitch line forms an acute angle in relation to said movable jaw surface plane" and the corresponding functional benefit in claim 13, element d lines 3-7 that state "wherein said means assists in urging said movable jaw member to a selected position moving from the open state to the closed state resulting in said movable jaw member in a secured position upon the fastener against moving toward the open state" with a supporting explanation of the above quoted segments of claim 13, elements b and d in paragraphs 114 and 117 of the specification. In

essence, focusing on Figure 5, when the beam 52 is urged in direction 86 from the means for urging 59 results in the moveable jaw member 40 moving in direction 62 termed "cinching", thus the reason for the acute angle 50 (see Figure 4) of the pitch line 49 is that it allows for the sliding of the beam serrated tooth face 113 and the movable jaw serrated tooth face 122 relative to one another when the beam 52 is urged in direction 86 from the means for urging 59 that results in moveable jaw member 40 moving in direction 62. Walz does not teach the aforementioned claim 13 (b) structure and associated claim 13 (d) functional benefit, in looking at Walz in Figure 1, the pitch line of the serrated toothed rack is perpendicular to the movable jaw (9) surface plane, not at an acute angle, thus Walz does not teach this structural limitation that is in Applicant's claim 1. The Examiner in the office action on page 2, paragraph 2, section b, lines 4-6, stating that Walz teaches "a serrated toothed rack (15) whose pitch line forms an acute angle in relation to said movable jaw surface plane (Column 3, Lines 28-34)" is a misinterpretation of Walz's teachings, as the column 3, lines 28-34 actually refer to the locking latch (20) teeth that are at an angle, wherein the locking latch (20) is at an angle of 45 degrees for movement in relation to the toothed surface plane, reference column 1, lines 28-35, thus Walz does not have a serrated tooth pitch line at an acute angle in relation to the movable jaw (9) surface plane, as is obvious in comparing Walz's Figure 1 to Applicant's Figure 4 specifically referring to angle 50. Furthermore, in looking at Walz in Figure 1, the associated function with the Applicant's angle 50 limitation in claim 1 would not be possible with Walz

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as if there were excessive urging on the part of spring (24), such that the toothed portions (15) and (21) were engaged with more force, it would not act to urge the movable jaw (9) to the closed state as Walz's tooth faces of the movable jaw (9) and latch (20) would remain static to one another as the tooth faces are normal to the force exerted by spring 24. Thus, Walz does not teach Applicant's claim 1 limitations of "whose pitch line forms an acute angle in relation to said movable jaw surface plane" and the associated functional benefit of "wherein said means assists in urging said movable jaw member to a selected position moving from the open state to the closed state resulting in said movable jaw member in a secured position upon the fastener against moving toward the open state", resulting in claim 1 being allowable, and with dependent claims 14-21 and 23 adding additional limitations that all eventually depend from claim 13, dependent claims 14-21 and 23 should be allowable.

In regards to rejected method claim 24, Applicant's providing step (a) includes a trigger that is pivotally attached to the movable jaw member, wherein Walz teaches a lever (27) that is pivotally attached to the latch (20) (see Figure 1) and not to the Applicants' movable jaw member 40, thus Walz does not teach the same trigger pivotal attachment as the Applicant's claim 24 providing step (a). Additionally, in relation to the use of Applicant's trigger in the claim 24 moving step (d) the trigger is moved to selectively position the movable jaw member, Walz teaches a method of using lever (27) by manually pushing on button (28) to bring the latch (20) out of engagement with the teeth of the slidable

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jaw, reference column 2, lines 50-55, with a rapid jerk by the operator of the handle (2) to cause the slideable jaw to move away from the stationary jaw and then release the lever (27) to cause engagement of the teeth of the movable jaw, reference column 2, lines 54-60, thus the method of use that Walz teaches with the lever (27) does not anticipate Applicant's claim 24 step (d) limitation, as Walz's latch (20) does not connect with the movable jaw (9) resulting in Applicant's claim 24 being allowable. Also, with Applicant's claim 25 depending from claim 24 by adding additional limitations, claim 25 should now be allowable.

In establishing a *prima facie* case of obviousness under 35 U.S.C. 103 it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been lead to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the Applicant's disclosure. See, e.g., *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434 (Fed. Cir. 1991) (The teaching or suggestion to make the claimed combination must not be based on the Applicant's disclosure). For a proper rejection under 35 U.S.C. 103 all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ("All words in a claim must be considered in

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judging patentability of that claim against the prior art."). Obviousness under 35 U.S.C. 103 can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998). The proposed modification for combining or individually modifying the prior art references cannot change the principal of operation of the references, if the principal of operation of the references is changed, then the teachings of the references are not sufficient to render the claim *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The motivation to modify the reference should manifest in some advantage or beneficial result, *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). Further, it should be noted that if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP §2143.03.

Wang teaches an adjustable wrench similar to Walz in that Wang teaches a ratchet (52) and dial (53) "trigger type" combination pivoting at member (55) wherein a spring (54) urges ratchet (52) to selectively engage fluted surface (28) to interlock with the ratchet (52) resulting in the movable jaw (20) being interlocked, reference column 2, line 42 to column 3, line 6. Also, Wang as in

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Walz teaches the fluted surface (28) or pitch line to be perpendicular to the movable jaw (20) surface, resulting in the movable jaw (20) remaining static upon the application of ratchet (52) force from spring (54) as per the design of Wang, reference Figures 4A and 4B and column 3, lines 1-6. Also, Wang teaches indicia to indicate the relative position by index (29) and mark (151) of the movable jaw (20) in relation to a particular size of fastener.

In the office action on page 5, in paragraph 5, the Examiner rejected claim 22 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 1,792,338 to Walz, in view of U.S. Patent No. 6,799,493 to Wang, Walz discloses the applicant's invention as previously described, but lacks the faster size indicia visibly disposed on each end of the fixed jaw segments and movable jaw member to identify the relative jaw position corresponding to fastener size. The Examiner also stated that Wang discloses an index (29) on the surface of the lower jaw, and an index mark (151) to indicated the size of the clamping space between the index and index mark and it would of obvious to one of ordinary skill in the art at the time the invention was made to combine the adjustable wrench disclosed by Walz, with the fastener size indicia disclosed in Wang in order to identify the relative jaw position corresponding to a fastener size.

In response, in referencing the previous remarks to Applicant's claim 13 rejection by the Examiner in relation to the Walz reference in relation to the Applicant's pitch line acute angle 50 not being taught by Walz, the same remarks hold true for the Wang reference, as Wang teaches the fluted surface (28) or

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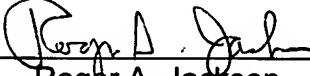
pitch line to be perpendicular to the movable jaw (20) surface, resulting in the movable jaw (20) remaining static upon the application of ratchet (52) force from spring (54) as per the design of Wang, reference Figures 4A and 4B, column 3, lines 1-6. Thus the Applicant's limitations in claim 13, element b, that has the following structural limitation at lines 7 and 8 of element b, "whose pitch line forms an acute angle in relation to said movable jaw surface plane" and the corresponding functional benefit in claim 13, element d lines 3-7 that state "wherein said means assists in urging said movable jaw member to a selected position moving from the open state to the closed state resulting in said movable jaw member in a secured position upon the fastener against moving toward the open state" with a supporting explanation of the above quoted segments of claim 13, elements b and d in paragraphs 114 and 117 of the specification are not taught by Wang. Even if Wang were modified to have the fluted surface (28) or pitch line to be at an acute angle to the movable jaw (20) surface, when the ratchet (52) engages the fluted surface (28) due to the urging from spring (54) the force between the ratchet (52) and the fluted surface (28) would be normal to one another still resulting in the movable jaw (20) being static thus not achieving Applicant's principal of operation and which does not teach the aforementioned limitations of Applicant's claim 13. Thus, resulting in Applicant's claim 13 being allowable as against the teachings of Walz in view of Wang and with claim 22 being dependent from claim 13 adding limitations to claim 13, claim 22 should now be allowable.

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Applicant respectfully requests that a timely notice of allowance be issued in this case.

Respectfully submitted,

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CERTIFICATE OF MAILING UNDER 37 C.F.R §1.8

I hereby certify that the attached **TRANSMITTAL OF RESPONSE TO OFFICE ACTION DATED NOVEMBER 27, 2005 AND RETURN RECEIPT POST CARD** is being deposited with the United States Postal Service as prepaid first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 27th day of November, 2005.



Roger A. Jackson